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OFFICE OF PETITIONS

In re Patent No. 7,439,017 :  
Issued: October 21, 2008 :  
Application No. 09/976,437 : ON APPLICATION FOR  
Filed: October 15, 2001 : PATENT TERM ADJUSTMENT  
Atty Docket No. 090900-0156 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705, filed on December 10, 2008. Patentee requests that the determination of patent term adjustment be corrected from two hundred sixty-one (261) days to five hundred seventy-three (573) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 261 days.

**BACKGROUND**

On January 18, 2008, the Office mailed a notice that the initial determination of patent term adjustment under 35 U.S.C. 154(b) to date is 120 days. On October 21, 2008, the application matured into U.S. Patent No. 7,439,017, with a revised patent term adjustment of 261 days. The Office determined that the 418 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) overlaps with the 316 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1) and (a)(2), accorded prior to the filing of the request for continued examination. As such, 102 additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the additional 99 days of Office delay pursuant to 37 CFR 1.702(a)(4) accorded subsequent to the filing of the RCE, and the applicant delay of 256 days, the

patent issued with a revised patent term adjustment of 261 (361 + 102 + 99 - 256) days.

On December 10, 2008, patentee timely submitted this request for reconsideration of the patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 573 days under the courts interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day."

At the outset, it is noted that Patentees have calculated a period of 390 days of patent term adjustment based on the mailing of the first Office action (restriction requirement) 14 months and 291 days after the date the application was filed, and the issuance of the patent four (4) months and 99 days after the payment of the issue fee. The Office, however, has entered an additional period of delay of 25 days for the mailing of a reply to an Office action on October 19, 2004, four (4) months and 25 days after the mailing of applicants' response filed on May 24, 2004 to the Office action mailed on October 2, 2003. Patentee did not include this 25 period in their calculation. As the period of Office delay is 415 days, rather than 390 days, the period of Office delay will be referred to as 415 days.

Further patentees have calculated a period of three year delay of 439 days. However, the three year period, which begins on October 15, 2004, three years from the filing date of October 15, 2001, and ends on December 7, 2005, the date a request for continued examination was filed, is 418 days. It is further noted, that, under the Wyeth analysis, the period of three year delay beginning on October 15, 2004 and ending on October 19, 2004 the date that an Office action in response to the reply filed on May 24, 2004 was filed, overlaps with the period of examination delay under 37 CFR 1.702(a)(1) by four (4) days. Accordingly, the non-overlapping period of three year delay asserted by patentee is 414 (418 - 4 overlap) days, not 439 days. Patentee's argument will be articulated accordingly.

Accordingly, patentee maintains that the total non-overlapping PTO delay under §154(b)(1)(A) & (B) is 829 (415 + 418 - 4 overlap) days as these periods do not occur on the same day.

Further, given the applicant delay of 256 days, patentee asserts entitlement to 573 (829 - 256) days of patent term adjustment.

### OPINION

Patentee's interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg.

56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the application filing date under 35 U.S.C. 111(a), October 15, 2004, and ending on the date of filing of a request for continued examination (RCE), December 7, 2005 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). The relevant period ends with the filing of the RCE as the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) does not include the period subsequent to the filing of the RCE. 35 U.S.C. 154(b)(1)(B)(i).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1) and (a)(2), 316 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the filing of the request for continued examination. Pursuant to 35

U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 102 non-overlapping days of patent term adjustment accrued for Office issuance of the patent more than 3 years after the filing date of the application.

316 of the 418 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 316 days of patent term adjustment under 37 CFR 1.702(a)(1) and (a)(2). Entry of both the 316 days and the 418 days is neither permitted nor warranted. 517 days is the actual number of days issuance of the patent was delayed.

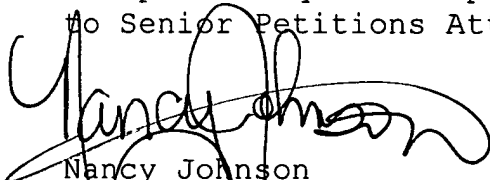
Accordingly, at issuance, the Office properly entered 102 additional days of patent term adjustment for the Office taking in excess of three years to issue the patent.

#### CONCLUSION

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 261 days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood, at (571) 272-3231.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the typed name and title.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions